

REMARKS

The present amendment is supplemental to the Amendment filed December 23, 2009. Favorable reconsideration and allowance of the claims are requested in view of the foregoing amendments and the following remarks.

I. Examiner Interview, Claim Status and Amendments

Applicants thank Examiner Chong for the brief telephone interview on March 2, 2010, during which the Examiner agreed to enter and consider this Supplemental Amendment.

Claims 43-47 presently appear in this case and stand rejected. No claims have been allowed.

By way of the present amendment, claim 43 has been amended to exclude neferine, liensinine and isoliensinine from the recited bisbenzylisoquinoline derivatives. As to the use of this exclusionary proviso clause, it is well established that there is nothing inherently ambiguous or uncertain about a negative limitation so long as the boundaries of the scope of protection are set forth definitely, albeit negatively, such that the claim complies with the requirements of 35 U.S.C. 112, second paragraph. The negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. In re Johnson, 558 F.2d 1008,

1019, 194 U.S.P.Q. 187, 196 (C.C.P.A. 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also, Ex parte Grasselli, 231 U.S.P.Q. 393 (Bd. App. 1983), aff'd mem., 738 F.2d 453 (Fed. Cir. 1984); See M.P.E.P., Eighth Ed., Rev. 7 (July 2008) at §2173.05(i). in the present case, support can be found at least in paragraphs [0028] to [0030] of Patent Application Publication No. 20070027181, which is the publication of the present application. Thus, the amendment is not new matter.

New claims 48-51 have been added.

Claims 48 and 49 define the bisbenzylisoquinoline derivative of claim 43. Support can be found in claim 43 and in paragraphs [0139] to [0141] and [0144].

Claim 50 defines the pain of claim 43. Support can be found in paragraph [0101].

New independent claim 51 corresponds to claim 43, as it stood prior to the instant amendment and without the proviso clause, but further defines the type of pain to be treated.

Claim 45 has been cancelled without prejudice or disclaimer thereto. Applicants reserve the right to file a continuation or divisional application on any cancelled subject matter.

No new matter has been added by the above claim amendments.

Claims 43-44 and 46-51 are pending upon entry of this amendment, and these claims define patentable subject matter warranting their allowance for the reasons discussed in the response filed December 23, 2009 and herein below.

II. Anticipation Rejection

Claims 43-47 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Hu (US 5,627,195) for the reasons set forth on page 5 of the Office Action. This rejection is respectfully traversed. The arguments set forth in the response filed December 23, 2009 are reiterated herein by reference.

By this amendment, main claim 43 has been amended to exclude neferine, liensinine or isoliensinine. New dependent claims have been added that also exclude these compounds by specifying a specific benzyliisoquinoline derivative and/or a specific kind of pain. Accordingly, this amendment excludes the compounds (i.e., neferine, liensinine and isoliensinine) in Hu, which fall within the scope of the compounds of formula I and formula II. Therefore, it is clear that the amended claims are not anticipated by Hu, and the rejection should be withdrawn for this reason.

Further, new claims 50 and 51 also specify particular kinds of pain to be treated. Specifically, the claims call for treating pain selected from the group consisting of headache,

toothache, neuralgia, arthralgia, myalgia, dysmenorrhea, bruise pain, postoperative pain and traumatogenic pain.

By contrast, in Hu, there is neither a teaching nor a suggestion about such specific pain, as recited in claims 50-51. Hu relates only to conjunctivitis and keratitis as a target disease. For this additional reason, Hu cannot anticipate these claims.

It should also be noted that new claim 50 depends on claim 43, and therefore it too excludes neferine, liensinine or isoliensinine from the recited bisbenzylisoquinoline derivatives. As discussed above, this is another reason why Hu cannot anticipate this claim.

Lastly, it should be noted that new independent claim 51 corresponds to claim 43, as it stood prior to the instant amendment (i.e., it does not contain the negative proviso clause), with the exception that it now defines the type of pain to be treated. As discussed above, this pain is not disclosed nor suggested in Hu. Also, as explained in the last response, though neferin is mentioned in a list of compounds as being one example of a tetrandrine agonist, neferin is mentioned in name only and there is no example of administering neferin in any method, let alone one for treating the specifically recited pain in claim 51. Nor is there any experimental data for neferin. Instead, it is only tetrandrine as such whose effect is confirmed

by experimental data in Hu, but again this is for treating ocular inflammation, not the specific pain as recited in new claim 51.

Also, there is no disclosure as to whether neferin would be effective to treat pain at all. Likewise, there is no disclosure of an effective dosage of neferin for treating any pain. As such, Applicants respectfully submit that there is no disclosure for ascertaining what would be an effective amount of neferin to treat the specific pain recited in claim 51. For these reasons, it is believed that Hu fails to anticipate new claim 51.

In view of the above, Applicants respectfully submit that the amended and new claims are not anticipated by Hu, and the rejection should be withdrawn.

III. Conclusion

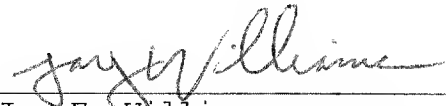
Having addressed all the outstanding issues, this paper is believed to be fully responsive to the Office Action. It is respectfully submitted that the claims are in condition for allowance, and favorable action thereon is requested.

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Suppl. Amdt. dated March 3, 2010
Reply to Office Action of September 24, 2009

If the Examiner has any comments or proposals for expediting prosecution, please contact the undersigned attorney at the telephone number below.

Respectfully submitted,

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